In re Application of: PATENT
   Tamburini et al.   Attorney Docket No.: AERO1130-4
Application No.: 09/974,026
Filed: October 10, 2001
Page 2

REMARKS

Rejection Under 35 USC § 112, First Paragraph (Written Description)

A.   Applicants have shown that the instant application is *identical* to the prior parent application (or U.S. Application No. 09/144,428, or U.S. Patent No. 6,583,108), and therefore a safeguard statement incorporating the parent application by reference is not necessary and the application is a continuation prosecution application of the parent containing no new subject matter.

According to the Office Action, Applicants have the burden of explaining the inconsistency between the instant continuation written description and that of the parent written description (PCT/US/US97/03894 or U.S. Patent No. 6,583,108).

To this end, Applicants have carefully reviewed the instant continuation application to that of the parent application (or 09/144,428) , which is a U.S. national phase application of the PCT/US/US97/03894 under 35 USC §371, filed March 10, 1997 (see U.S. Patent No. 6,583,108). Further, Applicants have also carefully compared PCT/US/US97/03894 application to that of the published U.S. Patent No. 6,583,108. All applications contain the *identical* written description including the same: Title, Abstract, Field of the Invention, Background of the Invention, Brief Summary of the Invention, Description of the Drawings, FIGs. 1-14, Detailed Description, and Sequence Listing of the Invention including all examples, tables and formulas incorporated therein. In short, the instant application is a true continuation prosecution application as filed under 37 USC 15.3(d), claiming benefit of an earlier filing date in the United States under 35 U.S.C. §120 to 09/144,428.

Applicants note that instant application does not include a statement incorporating by reference 09/144,428 (or U.S. Patent No. 6, 583, 108) in its entirety, because the instant application is a mere copy of the prior application (or PCT/US97/03894, now U.S. Patent No. 6, 583, 108). Further proof of this is shown in the filing transmittal, a copy of the first page which

In re Application of:
      Tamburini et al.
Application No.: 09/974,026
Filed: October 10, 2001
Page 3

                                                        PATENT
                          Attorney Docket No.: AERO1130-4

was retrieved from PAIR and is attached as Exhibit A. Therefore, since the instant application properly claims benefit of an earlier U.S. filing date to 09/144,428, and the two applications are *identical*, there is no need to "incorporate by reference" all that is in 09/144,428.

      B.   The Office Action concedes that the parent application teaches activity of SEQ ID NOs: 5, 7 and 8, and because the instant application properly claims benefit to the parent application (or 09/144,428) and is identical to 09/144,428, it must also be true that the instant application discloses the same activity of SEQ ID NOs: 5, 7 and 8.

According to the Office Action the "current application is a *continuation* of 09/144,428, which has taught activity of SEQ ID NOs: 5, 7 and 8 polypeptides but not in the specification of the instant application (page 3 of Office Action)." Applicants respectfully traverse this written description rejection.

As stated above, the instant application, a continuation prosecution application is *identical* to that of the 09/144,428 and there is *no inconsistency* between the two applications. Therefore, because there is no inconsistency between the instant application and that of 09/144,428, if the 09/144,428 teaches activity for SEQ ID NOs: 5, 7 and 8 polypeptides, so must the instant application.

Accordingly, all claims are in condition for allowance, and such action is hereby respectfully requested.

      C.   The claims are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which allegedly was not described in the instant specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention.

According to the Office Action, although Applicants were in possession of the nucleic acid sequences SEQ ID NOs: 5, 7, and 8, Applicants are not in possession of function the SEQ ID NOs: 5, 7, and 8, thereof. Applicants respectfully traverse this rejection.

In re Application of: PATENT
    Tamburini et al.   Attorney Docket No.: AERO1130-4
Application No.: 09/974,026
Filed: October 10, 2001
Page 4

As stated above, Applicants have shown that because the instant application is *identical* to 09/144,428, and since 09/144,428 teaches activity of SEQ ID NOs: 5, 7 and 8 polypeptides, so must the instant application. Thus, Applicants *are* in possession of function the SEQ ID NOs: 5, 7, and 8.

In view of the foregoing, the present specification contains a complete description of the invention sufficient to demonstrate that the Applicants, at the time the application was filed, had possession of SEQ ID NOs: 5, 7 and 8 polypeptides and their function. Accordingly, it is respectfully submitted that the rejection of claims 12-17 under 35 U.S.C. § 112, first paragraph, as allegedly lacking adequate written description, is not properly applied. Reconsideration and withdrawal of the rejection are therefore respectfully requested.

CONCLUSION

In view of the above amendments and remarks, reconsideration and favorable action on all claims are respectfully requested. In the event any matters remain to be resolved, the Examiner is requested to contact the undersigned at the telephone number given below so that a prompt disposition of this application can be achieved. No fee is believed due in connection with this Response. However, the Commissioner is hereby authorized to charge any fees that

In re Application of:
    Tamburini et al.
Application No.: 09/974,026
Filed: October 10, 2001
Page 5

PATENT
Attorney Docket No.: AERO1130-4

may be associated with this communication, or credit any overpayment to Deposit Account

No. 07-1896.

Respectfully submitted,

Date: February 15, 2005

Lisa A. Haile, J.D., Ph.D.
Registration No.: 38,347
Telephone: (858) 677-1456
Facsimile: (858) 677-1465

USPTO CUSTOMER NUMBER 28213
DLA PIPER RUDNICK GRAY CARY US LLP
4365 Executive Drive, Suite 1100
San Diego, California 92121-2133

UTILITY PATENT APPLICATION TRANSMITTAL
Submit an original and a duplicate for fee processing
(Only for new nonprovisional applications under 37 CFR 1.53(b))

ADDRESS TO:	
Assistant Commissioner for Patents Box Patent Application Washington, D.C. 20231	Attorney Docket No. 96-223-ZZ First Named Inventor Tamburini et al Express Mail No. EL 921553446

APPLICATION ELEMENTS	ACCOMPANYING APPLICATION PARTS
1. ☒ Transmittal Form with Fee	9. ☐ Assignment Papers
2. ☒ Specification (including claims and abstract) [Total Pages 69]	10. ☐ Power of Attorney
3. ☒ Drawings [Total Sheets 41]	11. ☐ English Translation Document (if applicable)
4. ☒ Oath or Declaration [Total Pages 4]	12. ☐ Information Disclosure Statement (IDS)
a. ☐ Newly executed	☐ PTO-1449 Form
b. ☒ Copy from prior application	☐ Copies of IDS Citations
[Note Boxes 5 and 18 below]	13. ☐ Preliminary Amendment
i. ☐ Deletion of Inventor(s) Signed statement attached deleting inventor(s) named in the prior application	14. ☒ Return Receipt Postcard (Should be specifically itemized)
5. ☐ Incorporation by Reference: The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied under Box 4b, is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.	15. ☐ Certified Copy of Priority Document(s)
	16. ☐ A Request for non-publication pursuant to 35 USC 122(b)(2)(B)(i)
	17. ☐ Other:
6. ☐ Computer Code Listing (See 1.96)	
a. ☐ Microfiche Appendix	
b. ☐ CD-Rom (in duplicate, with separate transmittal)	
7. ☐ Nucleotide and/or Amino Acid Sequence Submission	
a ☐ Computer Readable Copy	
b. ☐ Paper Copy	
c. ☐ Statement verifying above copies	
8. ☐ Small Entity Status	
☐ is claimed	
☐ Statement filed in prior application; status still proper and desired	
☐ is no longer claimed.	

18. ☒ This is a CONTINUING APPLICATION. Please note the following

   a. ☐ This is a ☒ Continuation ☐ Divisional ☐ Continuation-in-part
     of prior application U.S.S.N. 09/144,428.

   b. ☐ Cancel in this application original claims   of the prior application before calculating
     the filing fee. (At least one claim must remain.)

   c. ☒ Amend the specification by inserting before the first line the sentence:
     This is a ☒ continuation ☐ divisional ☐ continuation-in-part
     of application U.S.S N. 09/144,428, filed August 31. 1998, which is a continuation in part
     of PCT/US97/03894, filed March 10, 1997, which is a continuation in part of U.S.S.N.
     08/725,251, filed October 4, 1996, which claims the benefit of U.S.S.N. 60/019,793,
     filed June 14, 1996, and claims the benefit of U.S.S.N. 60/013,106, filed March 11, 1996.

   d ☐ The prior application is assigned of record to   .